



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,644	07/28/2003	Gregory A. Ehlers	68,180-005	4901
26753	7590	11/09/2007		
ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/628,644

### Applicant(s)

EHLERS ET AL.

### Examiner

Igor N. Borissov

### Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-30,33 and 35-61 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 36-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-30,33,40-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/2007 has been entered.

### ***Response to Amendment***

Amendment received on 10/26/2007 is acknowledged and entered. Claims 4-7 and 36-39 have previously been withdrawn. Claims 2 and 34 have been canceled. Claims 1, 13, 23, 33, 35, 54, 56, 58, 60 and 61 have been amended. Claims 1, 3-30, 33 and 35-61 are currently pending in the application.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 37 and 42 of copending Application No. 10/628,519, and over claims 1 and 29 of copending Application No. 10/628,504. While the conflicting claims are not identical, they are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 8-30, 33, and 41-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers et al. in view of Peevey (US 7,043,459 B2).**

Claims 1 and 33. Ehlers et al. (Ehlers) teaches a method and apparatus for providing at least one energy management program to a customer of a utility of a commodity, the program aimed at managing demand for the commodity, the utility

delivering the commodity to at least one customer site, the customer site having a plurality of devices which use the commodity, including the steps of:

defining the program having a subset of the plurality of devices at the customer site for which usage of the commodity may be managed by the utility by activating the program (Ehlers indicates specifically designed computer programs to implement said system for each particular customer, thereby suggesting "defining" feature; C. 3, L. 35-47; C. 5, L. 45-55; C. 9, L. 9-10, 51-53);

allowing the customer to selectively subscribe to the program (C. 5, L. 52-55; C. 32, L. 57 – C. 33, L. 3);

delivering the commodity to the subset of devices (C. 3, L. 57-65);

measuring the instantaneous rate at which the commodity is being delivered to the subset of the devices (C. 15, L. 5-8);

sending the instantaneous rate of commodity consumption for each device within the subset to the utility (C. 15, L. 5-8).

determining at the utility, in real time, the capacity of commodity that can be managed by the utility by activating the energy management program, the capacity being determined by the instantaneous rate at which the commodity is being delivered to the subset of the plurality of devices (C. 15, L. 5-8);

selectively activating the energy management program to manage the usage of the commodity (C. 9, L. 9-10, 51-53);

determining, in real time, at least one of a rate and a change in a rate at which the commodity is being delivered to the subset of the devices after activation of the energy management program (C. 15, L. 5-8).

Ehlers does not specifically teach that said transmitted to the utility instantaneous rate of commodity consumption for each device, is transmitted in real time.

Peevey teaches a method and apparatus for metering electricity usage and electronically providing information associated therewith, wherein meters, installed at the consumer premises, communicate metered data in real time to a requested entity (C. 5, L. 14-20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ehlers to include that said transmitted to the utility instantaneous rate of commodity consumption for each device, is transmitted in real time, as disclosed in Peevey, because it would advantageously allow to avoid labor and time intensive manual inspection of meters, as specifically stated in Peevely (C. 2, L. 48-49). Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claim 3. Said method, including the step of:

determining an actual change in a rate of consumption of the commodity after activation of the program and recording the rate of change in a memory (C. 15, L. 5-8).

Claim 8. Said method, including the step of: providing a user interface for interaction with the customer (C. 9, L. 47 – C. 10, L. 8).

Claims 10 and 41. Said method, wherein each device has an associated node, and the method includes the step of allowing the customer to control one or more of the devices through the associated node (C. 10, L. 28-31).

Claims 11 and 42. Said method, wherein the utility delivers the commodity to a plurality of customer sites, each customer site having a plurality of devices and the step of defining the program includes the step of including within the program all devices of a similar type at each customer site (C. 12, L. 2-61).

Claims 12 and 43. Said method, wherein the utility delivers the commodity to a plurality of customer sites, each customer site having a plurality of devices and the step of defining at least one program includes the step of defining a plurality of programs, each program having a respective subset of the devices (C. 12, L. 2-61).

Claims 13 and 44. Said method, including the step of: activating the program; and,  
allowing the customer to cancel the program when activated (C. 32, L. 57 – C. 33, L. 3).

Claims 14-17 and 45-48. Said method, including the step of: setting a budget goal; and, monitoring an aspect of usage of the commodity related to the budget goal (C. 14, L. 60 – C. 15, L. 49).

Claims 18, 19, 49 and 50. See reasoning applied to claims 1 and 30.

Claims 20-22 and 51-53. Said method, wherein the commodity is electrical power, water and gas.

Claims 23-30 and 54-61. See reasoning applied to claims 1 and 30.

**Claims 9 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehlers et al. in view of Peevey and further in view of Official Notice.**

Claims 9 and 40. Ehlers and Peevy teaches all the limitations of claims 9 and 40, including that said second microcomputer, which is installed at the customer premises, is provided with an appropriate network/bus interface (C. 9, L. 56-57), except specifically teaching that said interface includes a web browser. Official notice is taken

that it is old and well known to use a browser to access the Internet, which is largest existing network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ehlers and Peevy to include that said interface includes a web browser, because it would advantageously allow to save funds by employing the existing network rather than build a dedicated network.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-30, 33 and 35-61 have been considered but are moot in view of the new ground(s) of rejection.

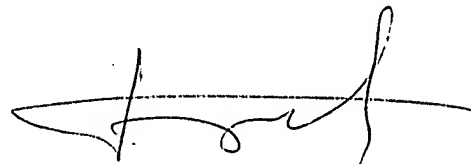
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

11/06/2007



IGOR N. BORISSOV  
PRIMARY EXAMINER